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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,917	01/09/2002	Kendell Simm	SIMM-CIPI	4732

7590

07/28/2003

Curt Harrington  
Suite 250  
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Long Beach, CA 90815

EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/28/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/045,917

Applicant(s)

SIMM ET AL.

Examiner

Jila M Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,9,11-13 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 6,7,10,12,14,15 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 19 is objected to because of the following informalities: It appears that claim 19 should depend from claim 16 and not claim 15. Appropriate correction is required.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because in Figure 6 embodiment, reference character "43" has been used to designate both the frustoconical receptacle and the tapered flanges. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 8-9, 11, 13 and 16-18 are rejected under 35 U.S.C. 103(a) as being obvious over Sagstetter (5,409,112) in view of Seeley (3,746,155). Sagstetter '112 discloses a hypodermic needle holder for safely storing and disposing of a hypodermic needle, and comprising: a body portion and a lid portion (3, 4) connected to said body portion and a main opening lockably coverable by said lid portion; there are at least a

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plurality of needle retaining openings (35, 50, 5) in communication with said main opening for frictionally engaging and retaining said hypodermic needle by at least frictional engagement upon insertion of said hypodermic needle within said needle retaining opening; and support structure , connected to said body portion, for enabling said hypodermic needle holder to be stably supported and utilized for frictionally engaging and retaining said hypodermic needle without manual grasping. See Figure 2 embodiment. Sagstetter `112 does not appear to teach each needle retaining opening associated with and in communication with an isolated chamber. Seeley `155 discloses a hypodermic needle holder having a plurality of needle retaining openings associated with and in communication with isolated chambers for better sorting and separating the items being disposed.(see Figure 3 embodiment and column 1, lines 41-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide isolated chambers associated with each needle retaining openings of Sagstetter `112 as taught by Seeley `155 to better sort and separate the items being disposed therein.

With respect to claim 3, note the raised projection on the lid (latch in Figure 2 embodiment) which engages and fits within said main opening.

With respect to claim 5, see Figure 3 embodiment which will frictionally engage and retain a hypodermic needle.

With respect to claim 8, note the container 5, in Figure 2 embodiment.

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With respect to claim 9 which further limits the shape of the container, this would be a design choice depending on the size and make of the hypodermic syringe and the routine optimization expected by one of ordinary skill in the art.

With respect to claim 11, Official Notice is taken that it is old and conventional to provide a layer of adhesive to holders for enhancing the upright stability of the holder.

With respect to claim 13 which further limits the material of the holder, this would be a design choice since, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 16-18 are directed to the obvious method of using the hypodermic needle holder of Sagstetter '112 comprising the steps of:

- a) Affixing a hypodermic needle holder to an object;
- b) Advancing a hypodermic needle supported by a hypodermic syringe into said opening;
- c) Frictionally engaging said hypodermic needle to said needle retainer;
- d) De-coupling said hypodermic needles from said needle and inhibit its cross contamination; and removing said hypodermic syringe away from said opening.

#### ***Allowable Subject Matter***

5. Claims 6-7, 10, 12, 14 –15 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

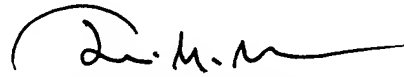
#### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (703)305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

J. MOHANDESI  
PATENT EXAMINER



Jila M Mohandesi  
Examiner  
Art Unit 3728

JMM  
July 24, 2003